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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,584	05/05/2006	Joseph McCrossan	P35470-03	9015

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WASHINGTON, DC 20036

EXAMINER

KHAN, ASHER R

ART UNIT	PAPER NUMBER
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2621

NOTIFICATION DATE	DELIVERY MODE
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09/02/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/578,584	Applicant(s) MCCROSSAN ET AL.	
	Examiner ASHER KHAN	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 11 is/are rejected.
- 7) ☒ Claim(s) 3 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject.

Claims 1 and 3-5 disclose a "recording medium" (claim 11, line 1). Both said claim and the respective specification fail to disclose whether said "recording medium" is limited to a non-transitory medium or transitory propagating signal. Reading said claims under the broadest reasonable interpretation said "recording medium" is considered to read on a transitory propagating signal. A claim directed to only signals per se is not a process, machine, manufacture, or composition of matter and therefore is not directed to statutory subject matter. See MPEP § 2106. Thus, said claims are not considered statutory.

Claim 11 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. It is noted that a statutory process under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, a method for recording on recording

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medium comprising generating, recording and overlaying is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine.

Allowable Subject Matter

1. Claims 3 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,907,658 to Murase et al. "Murase".

As to claims 1 and 11, Murase discloses a recording medium (Fig. 2A) having recorded thereon a video stream (Fig. 19B. video) and a graphics stream (Fig. 19B, sub-picture(SP); "...the sub-picture data may include vector graphics..", Col. 42 lines 62-67) wherein:

the video stream represents a moving picture made up of a plurality of pictures (Fig. 18);

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the graphics stream (Fig. 19B, sub-picture(SP); "...the sub-picture data may include vector graphics..", Col. 42 lines 62-67) is used for overlaying a menu on the moving picture ("the images (menus) of sub-picture packs... are superimposed on image...", Col. 24 line 64 to col. 25, lines 6), and includes interactive control information (Figs. 7D "management information pack", 10A "PCI" and 19A "management information pack") and graphics data (Fig. 19B, sub-picture(SP); "...the sub-picture data may include vector graphics..", Col. 42 lines 62-67) ; the graphics data is used for generating both the menu (Figs. 20 and 36) and an effect presented for introducing the menu (Moving from VOB 7~12 to VOB 25~30 and so on; Fig. 36; "...a menu image is reproduced for five to six second..." Col. 37 line 39 to Col. 38, line 53); the interactive control information includes a plurality of pieces of composition information (VOBs) defining a sequence of display compositions of graphics constituting the effect (Col. 37 line 39 to Col. 38, line 53); and

each piece of composition information shows (i) a bounding area (e.g., the area which bounds each displayed video frame as illustrated in Fig. 36) on a graphics plane within which a respective display composition (video7 to 12 or video25 to 30 or video 48 to 53 or video 65 to 70 or "...a shot of European coasts.." or "...VOB# 21 to VOB# 40... .. include a shot of European sceneries filmed from a train window.."; fig. 36 and etc) is rendered and (ii) a duration after which the display composition (video7 or video25 or video 48 or video 65; fig. 36) is replaced by a subsequent display composition to be rendered within the same bounding area ("... first question is reproduced for about twenty seconds...", "second question is reproduced for about 20 seconds..." ; Col. 37 line

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39 to Col. 38, line 53; It is noted that the timeline in Fig. 36 shows a duration for each video).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,907,658 to Murase et al. "Murase" in view of U.S. Patent 6,240,555 B1 to Shoff et al. "Shoff"

As to claims 4, Murase discloses everything claimed as applied in claims 1 above. Murase further discloses the graphics stream includes one or more pieces of pallet data (Fig. 36 items #1 to #3). However Murase does not expressly disclose the interactive control information includes a plurality of pieces of page information each defining a page of the menu available for presentation; and each piece of page information includes a pallet ID uniquely identifying a piece of pallet data to be used for presentation of a respective page.

Shoff disclose the interactive control information includes a plurality of pieces of page information each defining a page of the menu available for presentation ("...supplemental content is constructed as a hypertext document which can be rendered by a browser..", Col. 12, lines 48-67); and each piece of page information

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includes a pallet ID uniquely identifying a piece of pallet data (e.g., HTML Tag, Table 2) to be used for presentation of a respective page (Table 2).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Murase with the teachings of Shoff. Rationale to combine would have been that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on (571)272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. K./

Examiner, Art Unit 2621

/Peter-Anthony Pappas/

Supervisory Patent Examiner, Art Unit 2621